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THIS DISPOSITION IS NOT  
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Paper No.

GDH/gdh

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board  
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Michael Muir  
v.  
Infectious Records, Inc.  
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Cancellation No. 30,332  
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Jill M. Pietrini and Andrew Klungness of Manatt, Phelps &  
Phillips, LLP for Michael Muir.

Steven Godsberg of Godsberg, Zankel & Golden P.C. for  
Infectious Records, Inc.  
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Before Quinn, Hohein and Drost, Administrative Trademark  
Judges.

Opinion by Hohein, Administrative Trademark Judge:

Michael Muir has petitioned to cancel the  
registration owned by Infectious Records, Inc. for the mark  
"INFECTIOUS RECORDS," which is registered in the stylized

Infectious Records

format shown below

for "compact discs, audio cassette tapes, video cassette tapes, laser discs, LP, EP and single records."<sup>1</sup>

As his sole ground for cancellation, petitioner alleges among other things that he "is in the music business and has continuously used the mark INFECTIOUS GROOVES" since January 1990, for musical sound recordings and pre-recorded compact discs and audio cassettes featuring music"; that, more particularly, he "has used the mark INFECTIOUS GROOVES for musical sound recordings in the United States long prior to any use, if at all, by Registrant of the mark INFECTIOUS RECORDS for compact discs, audio cassette tapes, video cassette tapes, laser discs, LP, EP and single records"; that "[r]egistrant's mark INFECTIOUS RECORDS is nearly identical to Petitioner's mark INFECTIOUS GROOVES and is used in connection with the same goods that Petitioner uses his mark"; that, "[o]n that basis, a likelihood of confusion exists between Petitioner's mark and Registrant's mark"; and that petitioner is the owner of an application, "Serial No. 75/429,145 filed February 5, 1998 for registration of the mark INFECTIOUS GROOVES for musical sound recordings," which "has been refused registration ... on the grounds that Petitioner's mark

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<sup>1</sup> Reg. No. 2,018,909, issued on November 26, 1996 from an application filed on July 31, 1995, which disclaims the word "RECORDS" and sets forth a date of first use anywhere and in commerce of August 10, 1994.

INFECTIOUS GROOVES is likely to be confused with Registrant's mark INFECTIOUS RECORDS."

Respondent, in its answer, has denied the salient allegations of the petition to cancel.<sup>2</sup>

The record consists of the pleadings and petitioner's notice of reliance on: (i) portions of the file history for his pleaded application; (ii) respondent's admission of petitioner's first set of requests for admission by its failure to respond thereto; and (iii) excerpts of various articles from newspapers, magazines and other printed publications. Neither petitioner nor respondent took any testimony or otherwise introduced any other evidence. Only petitioner filed a brief and neither party requested an oral hearing.

The copy of the portions of the file history of petitioner's pleaded application is sufficient proof of

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<sup>2</sup> Although respondent has additionally asserted, as equitable affirmative defenses, that "[p]etitioner's claims are barred by laches and/or estoppel" and that "[p]etitioner's claims are barred by unclean hands," such defenses not only have not been properly pleaded, in that the facts constituting the defenses have not been alleged, but in any event the defenses were not proven at trial. Likewise, while respondent has also alleged as an affirmative defense that "[p]etitioner's claims are barred as it has no rights in any mark 'Infectious' that are superior to the rights of Registrant," such a defense is merely an amplification of respondent's denial of petitioner's claim of priority of use and likelihood of confusion rather than, properly speaking, an affirmative defense and, in any event, no proof thereof was offered at trial. Accordingly, no further consideration will be given to any of respondent's putative affirmative defenses.

petitioner's standing to bring this proceeding inasmuch as it establishes his real interest in this matter. See, e.g., Ritchie v. Simpson, 170 F.3d 1092, 50 USPQ2d 1023, 1025-27 (Fed. Cir. 1999); and Lipton Industries, Inc. v. Ralston Purina Co., 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982). Specifically, such evidence demonstrates that, as pleaded in the petition for cancellation, petitioner filed application Ser. No. 75/429,145 on February 5, 1998 to register the mark "INFECTIOUS GROOVES" for "musical sound recordings; and pre-recorded compact discs and audio cassettes in International Class 9" which was rejected in light of respondent's involved registration on the basis that contemporaneous use of petitioner's mark for his goods is "likely to cause confusion" with respondent's mark for its goods. (Exhibits 1 and 2, respectively, of petitioner's notice of reliance.) Thus, and inasmuch as it is plain that (i) the goods of the parties are identical in part (namely, records, compact discs and audio cassettes) and are otherwise closely related (as respondent admitted by not responding to Request for Admission No. 22)<sup>3</sup> and (ii) the respective marks are substantially similar (given the suggestiveness of the term "GROOVES" and the genericness

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<sup>3</sup> Specifically, such request states: "Petitioner's sound recordings bearing INFECTIOUS GROOVES are related to Respondent's compact discs, audio cassette tapes, video cassette tapes, laser discs, LP, EP and single records bearing the mark INFECTIOUS RECORDS."

of the word "RECORDS")<sup>4</sup> when considered in their entirety, the focus of our inquiry is on which party has priority of use of the marks at issue as a trademark.

With respect thereto, it is clear that because respondent did not take testimony or introduce any other evidence in its behalf, the earliest date upon which it could otherwise rely for purposes of priority of use of its mark as a trademark for its goods would ordinarily be the July 31, 1995 filing date of the use-based application which matured into its involved registration. See, e.g., Lone Star Mfg. Co., Inc. v. Bill Beasley, Inc., 498 F.2d 906, 182 USPQ 368, 369 (CCPA 1974); Columbia Steel Tank Co. v. Union Tank & Supply Co., 277 F.2d 192, 125 USPQ 406, 407 (CCPA 1960); Hilson Research Inc. v. Society for Human Resource Management, 27 USPQ2d 1423, 1428-29 at n. 13 (TTAB 1993); and American Standard Inc. v. AQM Corp., 208 USPQ 840, 841-42 (TTAB 1980). Petitioner, however, concedes in his brief that respondent "first used INFECTIOUS RECORDS on August 10, 1994," the date of first use and first use in commerce stated in the involved registration. Accordingly, in order to prevail in this proceeding, petitioner must establish that he has priority of

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<sup>4</sup> As petitioner notes in his brief: "The term GROOVES in Petitioner's mark suggests record grooves, while Registrant's mark contains the term RECORDS. Thus, both marks share a similar meaning, records that are 'infectious.'"

use in that he has continuously used the mark "INFECTIOUS GROOVES" as a trademark for musical sound recordings since on or before August 10, 1994.

Petitioner maintains in his brief that his "priority of use has ... been established" because:

Petitioner first used the mark INFECTIOUS GROOVES in January of 1990 and has continuously used INFECTIOUS GROOVES ever since. (Notice of Reliance, Exhibits 5-45). .... Moreover, Registrant has admitted that Petitioner's use of INFECTIOUS GROOVES predated Registrant's use of INFECTIOUS RECORDS. (RFA Nos. 3-6 and 15). Therefore, no issue exists as to the priority of use relative to Registrant's use of INFECTIOUS RECORDS versus Petitioner's use of INDECTIUOUS GROOVES.

The evidence cited by petitioner, however, fails to demonstrate that he has continuously used the mark "INFECTIOUS GROOVES" as a trademark for musical sound recordings prior to or at least as early as August 10, 1994.

Specifically, the articles from newspaper, magazine and other printed publications which constitute Exhibits 5-45 of petitioner's notice of reliance show on their face that the term "INFECTIOUS GROOVES" is invariably used in reference to the name of a band or musical group rather than, as pleaded in the petition for cancellation, a trademark for or brand name of musical sound recordings. For example, Exhibit No. 44 to

petitioner's notice of reliance explicitly indicates in pertinent part that:

"Excel guitarist Adam Seigel has been playing recently with Infectious Grooves, a band that includes two members of Suicidal Tendencies ...." -- L.A. Times, December 16, 1991.

Likewise, for instance, Exhibit Nos. 21, 24, 26, 27, 31 and 34 to petitioner's notice of reliance each specifically refer, as respectively set forth below, to "INFECTIOUS GROOVES" as the name of a "band":

"Suicidal tendencies' leader Mike Muir leads Infectious Grooves, the band that opens for Suicidal at 8 p.m. Saturday at Mesa Amphitheatre." -- Arizona Republic, February 28, 1993;

"One reason for the unmet promise of menace was the dubious inclusion of Infectious Grooves, S.T. vocalist Mike Muir's spin-off band (which also includes S.T. bassist Robert Trujillo), in the opening slot for an over-generous 60-minute set." -- St. Louis Post-Dispatch, March 13, 1993;

"IT'S FINE that the hardcore-turned-speedcore quartet Suicidal Tendencies decided to create a funky alter ego, Infectious Grooves, and that the former have hired the latter to open for it on its current tour. The problem is that the Grooves are as offensive as they are infectious, due to the band's dubious sense of humor." -- Washington Post, March 19, 1993; .

"Tonight, if you're in a Mike Muir kind of mood, you can catch the hyperkinetic one twice at Avalon with his well-known hard rock/punk band Suicidal

Tendencies, which follows up a set by his funkier new outfit Infectious Grooves band." -- Boston Globe, March 19, 1993;

"When not playing with Suicidal Tendencies, singer Mike Muir and bassist Robert Trujillo moonlight in the groove-metal band Infectious Grooves ...." -- Phoenix Gazette, April 21, 1994; and

"Minstrelsy is alive and louder than ever with Infectious Grooves, a band from Los Angeles that performed at the Academy on Tuesday night. Infectious Grooves is a side project of Mike Muir and Robert Trujillo, the lead singer and bassist from Suicidal Tendencies." -- N.Y. Times, May 20, 1994.

None of the articles establishes, moreover, that as implicitly asserted in the petition for cancellation, petitioner is also the owner of such mark<sup>5</sup> inasmuch as the articles are admissible only for what they show on their face and constitute inadmissible hearsay if offered for the truth of the matter(s) set forth therein. Furthermore, it is noted that the earliest of the articles, although dated September 29, 1991 (and not January 1990 as petitioner asserts in his brief), refers to "INFECTIOUS GROOVES" as a service mark for a band or musical group which is perhaps co-owned by another person--Robert Trujillo--instead of just petitioner alone. In

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<sup>5</sup> Section 1(a)(1) of the Trademark Act, 15 U.S.C. §1051(a)(1), provides that only "[t]he owner of a trademark used in commerce may request registration of its trademark ... by paying the prescribed fee and filing ... an application ...." (*Emphasis added.*)



particular, Exhibit No. 45 to petitioner's notice of reliance states in relevant part that:

"And Jane's [Addiction's] drummer Stephen Perkins has turned up on the new debut album by Infectious Grooves, a side project of Mike Muir and Robert Trujillo from Suicidal Tendencies." -- L.A. Times, September 29, 1991.

Similarly, Exhibit No. 40 to petitioner's notice of reliance, while likewise dated before August 10, 1994, appears to indicate that another entity--Epic Records--owns the service mark rights to "INFECTIOUS GROOVES" instead of petitioner, as alleged in the cancellation petition. Specifically, such article states that:

"Epic Records' Infectious Grooves, a five piece [band] that features the talent of Suicidal Tendencies' Mike Muir and Robert Trujillo, started off strong but slowly lost momentum as time ticked away." -- Hollywood Reporter, April 21, 1992.

With respect to the admissions by registrant which are referred to in petitioner's brief as also showing that his use of the mark "INFECTIOUS GROOVES" predates registrant's use of the mark "INFECTIOUS RECORDS," a careful reading thereof discloses that there is no admission by respondent that petitioner, although admittedly the prior user, used the mark "INFECTIOUS GROOVES" as a trademark for musical sound recordings. The record, instead, reveals that Request for Admission Nos. 3 and 4 state only that, "at the time it

selected the mark INFECTIOUS RECORDS for use with compact discs, audio cassette tapes, video cassette tapes, laser discs, LP, EP and single records," respondent respectively "was aware of Petitioner" and "was aware of Petitioner's use of INFECTIOUS GROOVES." Requests for Admission Nos. 5 and 6 similarly state that, "at the time Respondent filed its U.S. application to register INFECTIOUS RECORDS for use with compact discs, audio cassette tapes, video cassette tapes, laser discs, LP, EP and single records," respondent respectively "was aware of Petitioner" and "was aware of Petitioner's use of INFECTIOUS GROOVES."

Request for Admission No. 15, which indicates that "[t]he mark INFECTIOUS RECORDS is used in advertisements for Respondent's compact discs, audio cassette tapes, video cassette tapes, laser discs, LP, EP and single records," fails to provide any proof of petitioner's alleged priority of use of the mark "INFECTIOUS GROOVES." While it appears that the reference thereto in petitioner's brief is a typographical error and that petitioner meant, instead, to cite Request for Admission Nos. 13 and/or 14, the admissions set forth therein, like those in Request for Admission Nos. 3-6, fail to demonstrate petitioner's claimed priority of use. This is because Request for Admission Nos. 13 and 14 merely provide that, "at the time Respondent first used the mark INFECTIOUS

RECORDS for Respondent's compact discs, audio cassette tapes, video cassette tapes, laser discs, LP, EP and single records," respondent respectively "was aware of Petitioner" and "was aware of Petitioner's use of INFECTIOUS GROOVES." There is no indication, however, that respondent's awareness of petitioner and his use of the mark "INFECTIOUS GROOVES" was in connection with the use of such mark as a trademark for musical sound recordings.

Finally, while it is noted in particular that Request for Admission No. 21 states that petitioner and respondent "both sell musical sound recordings under their respective marks INFECTIOUS GROOVES and INFECTIOUS RECORDS," the sole example of such use by petitioner which is of record demonstrates that the use of the mark "INFECTIOUS GROOVES" is as a service mark, that is, as the name of a band or musical group, and not as a trademark for musical sound recordings. Specifically, the copy of the specimens of use submitted by petitioner in connection with his application to register the mark "INFECTIOUS GROOVES" for musical sound recordings, pre-recorded compact discs and audio cassettes shows such mark used as (i) the name of the band or musical group whose recordings comprise a single audio cassette tape entitled "GROOVE FAMILY CYCO" and (ii) as part of the name of the band(s) or musical group(s) "SUICIDAL TENDENCIES & INFECTIOUS

GROOVES" whose recordings (along with those by such artists as "CYCO MIKE," "THE FUNERAL PARTY," "CREEPER" and "MUSICAL HEROIN") make up the compilation of performances listed on a single pre-recorded compact disc. (Exhibit 1 of petitioner's notice of reliance.) Such manner of use does not, by itself, constitute a showing of use of the mark "INFECTIOUS GROOVES" as a trademark for musical sound recordings, including pre-recorded compact discs and audio cassettes. See In re Peter Spirer, 225 USPQ 693, 695 (TTAB 1985). Even if it did, such use in any event is subsequent to respondent's August 10, 1994 date of first use inasmuch as the recordings bear the indefinite dates of "©1997" in the case of the compact disc and, while nearly illegible, what appears to be "©1994" for the audio cassette. Absent testimony or other evidence, however, such dates are respectively treated as being December 31, 1997 and December 31, 1994. See TMEP Section 903.07, which provides that "[w]hen only a year is given, the date presumed is the last day of the year."

Accordingly, because petitioner, as the party with the burden of proof in this proceeding, has not established a necessary element of his pleaded claim of priority of use and likelihood of confusion in that he has not proven that he first and continuously used the mark "INFECTIOUS GROOVES" as a trademark for musical sound recordings and pre-recorded

compact discs and audio cassettes featuring music since on or before the August 10, 1994 date of first use which petitioner has conceded that respondent is entitled to rely, the petition for cancellation must fail.<sup>6</sup>

**Decision:** The petition to cancel is denied.

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<sup>6</sup> Whether petitioner is entitled to relief under an additional or alternative claim of priority of use and likelihood of confusion with respect to his prior rights in the service mark "INFECTIOUS GROOVES" for musical entertainment services and respondent's mark "INFECTIOUS RECORDS" for its compact discs, audio cassette tapes, video cassette tapes, laser discs, LP, EP and single records is an issue which, since it has not been pleaded nor tried by the express or implied consent of the parties, we do not determine. Respondent need only defend a claim of which it has been given fair notice. If, however, such a claim has not been proven by petitioner, respondent was under no obligation to take testimony or submit other evidence in order to prevail nor, unlike petitioner, was it required to file a brief herein.